

## **REMARKS**

### **1. Rejection under 35 USC § 112: Claims 1 and 8**

Claims 1 and 8 stand rejected under 35 USC § 112, first paragraph, as failing to comply with the written description requirement. According to the office action, in claim 1 the limitation “configured to contact the skin of a user and detect one or more biofeedback signals from the skin of the user without application of an electrical signal to the user,” and in claim 8 the limitation “by contacting the skin of the user without introducing an electrical signal to the skin of the user” are not adequately described in the specification.

Applicants believe claims 1 and 8 are patentable in view of the above amendments. Current claim 1 relates to a biofeedback system including a biofeedback measuring device that is “configured to contact the skin of a user and detect and measure a body own electrical current.” Current claim 8 is directed to a biofeedback method including the step of “detecting a body own electrical signal.”

Applicants respectfully submit that it is well known to those skilled in the art that the body is capable of naturally producing electrical signals. These electrical signals may be measured at acupuncture points located on the body. Paragraph [0018] states that the “biofeedback device is configured as a device which measures an electrical property of human skin....” Paragraph [0020] states “[i]n particular, the biofeedback device 100 is configured to measure an electrical current at an acupuncture point and produce an indication.” Accordingly, Applicant’s invention is capable of measuring an electrical signal naturally produced by the body itself, as opposed to measuring the body’s resistance in response to a foreign (or external) current introduced to the body. In fact, “[b]ody own electrical currents in excess of 1600 nano-Amperes (nA) have been measured with this device” as stated in paragraph [0023]. (emphasis added).

Applicants respectfully submit that current claims 1 and 8 are sufficiently described in the specification and respectfully request withdrawal of the rejection.

### **2. Rejection under 35 USC § 112: Claim 1**

Claim 1 stands rejected under 35 USC § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. According to the office action, it is unclear how the cellular telephone has an

“embedded” biofeedback device. The office action notes that “embedded” means “to cause to be an integral part of a surrounding whole.” The office action also notes that in FIG. 1, separate devices include biofeedback device 100 and cell phone 130 and that the “embedded” language in the specification talks about components, but the components are not claimed.

Applicants believe claim 1 is patentable in view of the above amendment. Current claim 1 relates to a biofeedback system including a cellular telephone device component and a biofeedback measuring device component. Current claim 1 does not require the biofeedback measuring device component to be embedded in the cellular telephone device component. Applicants therefore respectfully submit that the meaning of the language of current claim 1 is sufficiently clear to satisfy section 112, paragraph 2 of the Patent Act. Accordingly, Applicants respectfully request withdrawal of this rejection.

Applicants have, however, submitted new claim 13 which relates to the biofeedback system of claim 1 “wherein the biofeedback measuring device is embedded within the cellular telephone device.” Applicants respectfully submit that support for this new claim may be found at least at paragraph [0041], stating

*[i]n a first embodiment of the biofeedback system 100, the biofeedback device 100 and the cellular telephone device 130 are combined in a single unit. That is, the circuitry and electrodes of the biofeedback device are embedded in the cell phone itself. The electrodes are located on the outside surface of the cell phone housing for access by a user. The hardware of the system operates in conjunction with software. The software also resides in the cell phone. (emphasis added)*

It is therefore respectfully submitted that the meaning of the language of new claim 13 is sufficiently clear to satisfy section 112, paragraph 2 of the Patent Act, when read in light of the specification.

### **3. Rejection under 35 USC § 112: Claims 1 and 8-11**

Claims 1 and 8-11 stand rejected under 35 USC § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. According to the office action, it is unclear how a biofeedback device included with a cell phone does not apply an electrical signal to the user where operation of the cell phone emits electromagnetic waves.

Applicants believe the claims are patentable in view of the above amendments. As pointed out above, Applicants have amended claims 1 and 8 to “detect a body own electrical

signal at an acupuncture point of the user” and “detecting a body own electrical signal by contacting an acupuncture point of a user,” respectively. Current claims 1 and 8 no longer require, for example, “without application of an electrical signal to the user.” Applicants therefore respectfully submit that claims 1 and 8-11 are sufficiently clear to satisfy section 112, paragraph 2 of the Patent Act. Accordingly, Applicants respectfully request withdrawal of this rejection.

Applicants have, however, submitted new claim 15 which relates to a cellular telephone device including electrodes that are “electrically isolated from the housing” of the cellular telephone device and that are configured to “detect body emitted electrical signals at an acupuncture point without introducing an electrical signal to the user.” Applicants respectfully submit that new claim 15 is sufficiently clear to satisfy section 112, paragraph 2 of the Patent Act.

As pointed out in the Office Action, the cellular telephone device may emit electromagnetic signals; however, the electrodes are electrically isolated from the cellular telephone. Thus, the electrodes do not introduce an electrical signal to the user, but rather detect an electrical signal naturally produced by the user. For example, as pointed out in Paragraph [0022], the shaft of the electrode, other than the skin contacting tip, may be plastic to electrically isolate the electrode. Therefore, the electrodes may detect body emitted electrical signals “without introducing an electrical signal to the user.”

**4. 35 U.S.C. § 102: Claims 1-3, 5-9, and 11**

Claims 1-3, 5-9, and 11 stand rejected under 35 U.S.C. § 102(b) as being anticipated by US 6,327,495 to Iwabuchi et al. (“Iwabuchi”).

Applicants believe the claims are patentable in view of the above amendments. Current claim 1 relates to a biofeedback system including a biofeedback measuring device “configured to contact the skin of a user and detect and measure a body own electrical current.” Current claims 2-3 and 5-7 relate to a biofeedback system including a biofeedback device “configured to detect a body own electrical signal at an acupuncture point of a user” and current claims 8-9 and 11 relate to a biofeedback method including the step of “detecting a body own electrical signal by contacting an acupuncture point of a user.”

In contrast, Iwabuchi does not disclose a device configured to detect a body own electrical signal. Rather, Iwabuchi primarily discloses the calculation of electric resistance

following the introduction of current to determine a user's body fat rate. Specifically, the Iwabuchi device has four electrodes A, B, C, D, a current generating circuit 22, and a voltage detecting circuit 23. Col. 5, ll. 15-18; Col. 5, ll. 51-58. The current generating circuit 22 applies a current at electrodes A and C and the voltage detecting circuit 23 detects the voltage applied to the body through electrodes B and D. Col. 6, ll. 47-54. The detected data is processed to determine an electric resistance, which is then used in combination with previously entered data such as height and weight, to calculate a user's body fat rate. Col. 6, ll. 54-67. Iwabuchi also mentions combining a blood pressure manometer or pulse monitor with the device to measure a user's blood pressure and pulse rate. Col. 9, ll. 32-54.

Because Iwabuchi fails to disclose a device configured to detect a body own electrical signal, Applicants respectfully submit that current claims 1-3, 5-9, and 11 are allowable over Iwabuchi. Accordingly, Applicants respectfully request withdrawal of the rejection.

**5. 35 U.S.C. § 102: Claims 1-4**

Claims 1-4 stand rejected under 35 U.S.C. § 102(b) as being anticipated by US 6,478,736 to Mault ("Mault").

Applicants believe the claims are patentable in view of the above amendments. Current claim 1 relates to a biofeedback system including a biofeedback measuring device "configured to contact the skin of a user and detect and measure a body own electrical current." Current claims 2-4 relate to a biofeedback system including a biofeedback device "configured to detect a body own electrical signal at an acupuncture point of a user."

In contrast, Mault, similar to Iwabuchi, does not disclose a device configured to detect a body own electrical signal. Rather, Mault discloses an integrated calorie management system that consists of a gas exchange monitor (GEM) that detects breath to calculate the user's resting metabolic rate (RMR). FIGS. 1 and 2; Col. 5, ll. 1-5. Mault also mentions an activity sensor 60, disclosed primarily as a pedometer, a heart rate monitor 74, and a body fat meter 76. Col. 9, ll. 46-67 to Col. 10, ll. 1-21. None of these devices disclosed in Mault, however, detect a body own electrical signal.

Because Mault fails to disclose a device configured to detect a body own electrical signal, Applicants respectfully submit that current claims 1-4 are allowable over Mault. Accordingly, Applicants respectfully request withdrawal of the rejection.

**6. 35 U.S.C. § 103: Claim 10**

Claim 10 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Iwabuchi in view of US 6,421,560 to Yoo (“Yoo”).

Applicants believe the claims are patentable in view of the above amendments. Current claim 10 relates to a biofeedback method including the step of “detecting a body own electrical signal by contacting an acupuncture point of a user.” As discussed above, Iwabuchi fails to disclose a device configured to detect a body own electrical signal. Yoo also fails to disclose a device configured to detect a body own electrical signal. Rather, Yoo relates to a device for guiding spots for acupuncture via showing the spots on a display device. FIGS. 6 and 7.

Because neither Iwabuchi nor Yoo, alone or in combination, teach or suggest a device configured to detect a body own electrical signal, Applicants respectfully submit that current claim 10 is allowable over Iwabuchi in view of Yoo. Accordingly, Applicants respectfully request withdrawal of the rejection.

**7. Conclusion**

For the foregoing reasons, Applicants respectfully submit that the presently amended claims are patentable and thus request allowance of these claims. Moreover, Applicants have submitted new claims, 12-15. For the reasons discussed within this response, none of the cited references, alone or in combination, teach or suggest the limitations of the new claims. Applicants therefore respectfully submit that the new claims are patentable and thus request allowance of these claims.

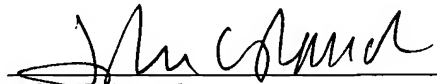
Application no. 10/734,066

Response dated: November 9, 2006

Reply to Notice of Non-Compliant Amendment dated: October 18, 2006

If, for any reason, the Examiner feels that the above amendments and remarks do not put the claims in condition for allowance, the undersigned attorney can be reached at (312) 321-4288 to resolve any remaining issues.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "John G. Rauch", written over a horizontal line.

John G. Rauch

Registration No. 37,218

BRINKS HOFER GILSON & LIONE  
P.O. BOX 10395  
CHICAGO, ILLINOIS 60610  
(312) 321-4200